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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,546	12/04/2000	Brian J. Green	S215-3PCIP	5165
24290	7590	04/26/2004	EXAMINER	
BRIAN D. SMITH, P.C. 1125 SEVENTEENTH STREET SUITE 600 DENVER, CO 80202			SLITERIS, JOSELYNN Y	
			ART UNIT	PAPER NUMBER
			3616	

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,546

Applicant(s)

GREEN ET AL.

Examiner

Joselynn Y. Sliteris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-7, 9, 10, 13-41 and 43 is/are pending in the application.
- 4a) Of the above claim(s) 5-7, 9, 10, 14, 15, 17, 33, 34, 36-40 and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 13, 16, 18-29, 32 and 41 is/are rejected.
- 7) ☒ Claim(s) 30, 31 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/19/02 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 5-7, 9, 10, 14, 15, 17, 33, 34, 36-40, and 43 remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Currently, there are no generic claims.
2. An action on the merits follows:

Oath/Declaration

3. The oath or declaration remains defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The current status of the parent application (Serial No. 09/210,464 filed 12/12/98 & 09/580,042 filed 5/26/00) for which domestic priority is being claimed needs to be updated.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner,

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applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 50A (page 17 line 17). Correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 13, 16, 18, and 21-23, are rejected under 35 U.S.C. 102(b) as being anticipated by Soo (U.S. Patent 5,342,071), as cited by Applicant.

7. Regarding claim 1, Soo discloses a suspension system comprising:

a wheel support member 30, 50 wherein each skate has a boot 10 and a plurality of wheels 35, 51 attached to the bottom of the boot 10;

attaching means 22, 36, 26, 34 for pivotally attaching said wheel support member 30, 50 at a single pivot point to the bottom of the skate boot 10 and allowing said wheel support member 30, 50 to move horizontally relative to the boot 10 at the pivot point; and

shock absorbing means 26 located between the boot 10 bottom and said wheel support member 30, 50 for cooperating with said attaching means 22, 36, 26, 34 so that said shock absorbing means 26 is engaged when said wheel support member 30, 50 pivots at the pivot point or moves relative thereto.

8. Regarding claims 2, 3, 13, and 16, Soo discloses a suspension system wherein:

said attaching means 22, 36, 26, 34 allows said wheel support member 30, 50 to move horizontally and vertically relative to the boot 10 at the pivot point;

said attaching means 22, 36, 26, 34 allows said wheel support member 30, 50 to move at the pivot point in any direction in the vertical plane in which the wheels 35, 51 rotate;

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said bottom of the boot 10 includes a sole plate to which said wheel support member 30, 50 is pivotally attached by said attaching means 22, 36, 26, 34; and

said shock absorbing means 26 comprises compressible material.

9. Regarding claim 18, Soo discloses an improved in-line skate having a boot 10 and plurality of wheels 35, 51 attached to the bottom of the boot 10, wherein the improvement comprises:

a front and a rear suspension system, each of which includes:

a wheel support member 30, 50 for rotatably supporting one or more wheels 35, 51 of the in-line skate;

attaching means 22, 36, 26, 34 for pivotally attaching said wheel support member 30, 50 at a single pivot point to the bottom of the boot 10 and allowing said wheel support member 30, 50 to move horizontally relative to the boot 10 at the pivot point; and

shock absorbing means 26 located between the boot 10 bottom and said wheel support member 30, 50 for cooperating with said attaching means 22, 36, 26, 34 so that said shock absorbing means 26 is engaged when said wheel support member 30, 50 pivots at the pivot point or moves horizontally relative to the boot 10 at the pivot point.

10. Regarding claims 21-23, Soo discloses an improved in-line skate wherein:

said front wheel support 30 supports at least two in-line wheels 35;

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said attaching means 22, 36, 26, 34 allows said wheel support members 30, 50 to move horizontally and vertically at the pivot point in the plane in which the wheels rotate;

said attaching means 22, 36, 26, 34 allows said wheel support members 30, 50 to move at the pivot point in any direction in the plane in which the wheels rotate.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soo in view of Oliemans et al. (U.S. Patent 5,704,620), as cited by Applicant.

13. Regarding claims 24 and 25, Soo discloses the claimed device except for the link member. Oliemans discloses that it is known in the art to provide a link member 902, 903, 906 (Figs. 9-12), 1607 (Fig. 16) pivotally connecting the front and rear wheel supports, the link member serving to keep the wheel supports aligned so that wheels attached thereto stay in alignment, and the link member permits vertical and horizontal movement of the wheel supports in the vertical plane in which the wheels rotate but restrains lateral movement of the wheel supports so that the wheel supports and wheels thereof stay in alignment. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the improved in-line skate of Soo with

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the link member of Oliemans, in order permit vertical and horizontal movement of the wheel supports in the plane of the wheel rotation but restrain lateral movement of the wheel supports so that the wheel supports and the wheels attached thereto stay in alignment.

14. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soo in view of Roman et al. (U.S. Patent 6,131,920).

15. Regarding claims 19 and 20, Soo discloses the claimed invention except for the brake having first and second pivoting means. Roman discloses that it is known in the art to provide a brake 19 having a brake element 15, 17, the brake having first pivoting means 12 attached to the rearward end 13 of the skate boot 2 and second pivoting means 16 attached to the rear wheel support 8 (Fig. 1) and wherein the first 12 and second 16 pivoting means cooperate to 1) move the brake element into contact with the rear wheel 9 when the skater shifts his or her weight so that more weight is placed on the rear wheel support than on the front wheel support, and 2) allow the brake element 15, 17 to move in conjunction with the rear wheel support and thereby stay out of contact with the rear wheel when the skater's weight is distributed equally to the front and rear wheel supports. Roman also discloses that it is known in the art to provide brake sensitivity means 21. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the improved in-line skate of Soo with the brake of Roman, in order to brake the rotation of the wheel and slow and/or stop the in-line skate.

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16. Claim 26, in the broadest interpretation, is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (U.S. Patent 5,690,344) in view of Chang (U.S. Patent 6,012,727).

17. Regarding claim 26, in the broadest interpretation, Chen discloses the claimed invention except for the receiving element being provided with at least one combined vertical and horizontal slot. Chang discloses that it is known in the art to provide a receiving element with at least one combined vertical and horizontal slot 21. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the receiving element of Chen with the combined vertical and horizontal slot of Chang, in order to provide easier pivotal movement of the wheel support member in the vertical and horizontal directions.

18. Claims 27, 28, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Chang as applied to claim 26 above, and further in view of Oliemans et al. (U.S. Patent 5,704,620), as cited by Applicant.

19. Regarding claims 27, 28, and 41, Chen and Chang disclose the claimed device except for the rigid link member. Oliemans discloses that it is known in the art to provide a rigid link member 902, 903, 906 (Figs. 9-12), 1607 (Fig. 16) attached by pivotable means between the bottom portions so that each wheel is capable of being moved independently to pivot the wheel support member to engage the shock absorbing means. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the suspension system of Chen and Chang with the link member of Oliemans, in order allow each wheel to be capable of being

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moved independently to pivot the wheel support member to engage the shock absorbing means while providing lateral stability.

20. Claims 29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Chang, Oliemans et al. as applied to claim 27 above, and further in view of Roman et al. (U.S. Patent 6,131,920).

21. Regarding claim 29, Chen, Chang, and Oliemans disclose the claimed invention except for a brake. Roman discloses that it is known in the art to provide a brake 19 having a brake element 15, 17 capable of contacting one of the skate wheels 9 to brake the wheel, the brake 19 being attached to the rearward end of the skate 13 by pivotable and vertically moving means 12 (Fig. 1) and to the rear wheel support by pivotable means 16 so that the brake element 15, 17 is capable of (1) pivoting the brake element 15, 17 into contact with the rear wheel 9 when the skater shifts his or her weight so that more weight is placed on said rear wheel support than on the front wheel support, and (2) allowing the brake element 15, 17 to move vertically in conjunction with the rear wheel support and thereby stay out of contact with the rear wheel when the skater's weight is distributed equally to the front and rear wheel supports. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the suspension system of Chen, Chang, and Oliemans with the brake of Roman, in order to brake the rotation of the wheel and slow and/or stop the in-line skate.

22. Regarding claim 32, Chen, Chang, and Oliemans, and Roman disclose the claimed invention except for the brake element including a high friction material. It

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would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the brake element including a high friction material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

In re Leshin, 125 USPQ 416.

Allowable Subject Matter

23. Claims 30, 31, and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

24. Applicant's arguments with respect to claims 1 and 18 have been considered but are moot in view of the new ground(s) of rejection.

25. Applicant's arguments filed 11/19/02 with respect to claim 26 have been fully considered but they are not persuasive.

26. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a single slot has both horizontal and vertical sections" on page 3 of applicant's remarks) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joselynn Y. Sliteris whose telephone number is 703-308-8225. The examiner can normally be reached on Mon-Wed 8:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul N. Dickson can be reached on 703-308-2089. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.


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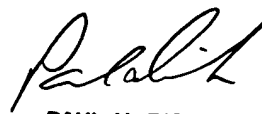
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JYS 
4/19/04

 4/20/04
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SUPERVISORY PATENT EXAMINER
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